

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of October 10, 2006 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Office is expressly authorized to charge any deficiencies or credit any over-payments to Deposit Account 50-0951.

In the Office Action, Claims 1, 4-30, 36, and 39-64 were rejected to under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,564,261 to Gudjonsson, *et al.* (hereinafter Gudjonsson) and U.S. Published Patent Application No. 2002/0023132 to Tornabene, *et al.* (hereinafter Tornabene). Additionally, Claims 4 and 39 were objected to under 35 U.S.C. § 112.

Applicants have amended independent Claims 24, 58, and 59 to further emphasize certain aspects of the invention. Applicants also have amended Claims 4 and 39 to overcome the objections noted in the Office Action. The amendments are fully supported throughout the Specification. (See, e.g., Specification, p. 11, lines 10-17; p. 12, lines 5-12; p. 13, lines 1-18; see also FIG. 1.) No new matter has been introduced by the claim amendments.

### **Claims 1, 23, 24, 28, 36, 58, and 59**

Applicants respectfully submit that neither Gudjonsson nor Tornabene teaches or discloses every feature recited in independent Claims 1, 23, 24, 28, 36, 58, and 59. For example, neither of the references teaches or suggests the comparison, identification or presentations pertaining to contact lists taught by Applicants' invention.

Specifically, Claims 1, 23, 28, and 36, as well as amended Claims 24, 58, and 59, each recite the following steps pertaining to the handling of contact list information for a plurality of chat session participants:

**comparing first and second contact lists; identifying common and non-common contacts between the first contact list and the second contact list; and displaying common contacts in a first visual list and non-common contacts in a second visual list.**

At page 3 of the Office Action, it is expressly noted that Gudjonsson fails to teach or suggest any of these steps. It is stated, however, that these steps are taught by Tornabene. The following language from Tornabene is explicitly cited as disclosing the steps:

"[0006] In one general aspect, information is shared among members of a group by storing information about all current members of the group, receiving instructions from a group member inviting a prospective member to join the group, sending an invitation to the prospective member, receiving a response from the prospective member, adding the prospective member to the group when the response is positive, and providing automatically updated services to current group members.

"[0007] Implementations may include sending the invitation by an e-mail message, an instant message, or in an on-line chat room. Implementations also may include receiving the response by an e-mail message, an instant message, or in an on-line chat room. The automatically updated services may include, for example, providing a list of current group members, sharing information in an address book, sharing information in a calendar, providing an online forum for current group members to chat with other group members, sending instant messages from a current group member to

other current group members, sharing data files among current group members, sharing a buddy list among current group members, and offering new services to current group members. The shared information may be updated based upon information entered by the current group members. In the shared address book, the information shared may include, for example, a name, an address (either personal or business), an email address, an instant message user identifier, a screen name, and a telephone number. In the shared calendar, the shared information may include, for example, a date, an appointment, an anniversary, a birthday, a holiday, and an invitation for other current group members to attend an event. For the shared data files, implementations may include sharing, for example, digital images such as photographs, text files, or multimedia files.

"[0008] In another general aspect, a communication system shares information among members of a group through a group administrator which processes information about current group members, a group communicator that delivers and exchanges information with both current and prospective group members, and a group information updater that provides automatically updated services to current group members."  
(Paragraphs [0006]-[0008].)

In another portion cited in the Office Action, Tornabene provides:

"[0077] The founder can designate other group members to manage the group as "owners" of the group. A group owner is allowed to change settings (e.g., homepage group title or description) for the entire group,

delete and edit group and other member's content, invite prospective members, change member/owner status of any other member, send administrative e-mails as an owner, and even remove troublesome members. Group owners are notified when there is an issue with member e-mail. If there are repeated delivery difficulties or excessive unsolicited bulk mail--an indication of possible mail list abuse--a member may be temporarily suspended from participating in the group mail list. The group owner may opt to resume delivery, remove the member from the group or resolve the issue later." (Paragraph [0077].)

#### **comparing first and second contact lists**

Applicants respectfully submit that Tornabene fails to teach or suggest the recited step of comparing first and second contacts lists. As the quoted language reveals, Tornabene's technique of "information sharing" entails "inviting a prospective member to join [a] group, sending an invitation to the prospective member," and, if the response is positive, adding the member to the group and automatically updating "services" to current members. (Paragraph [0006].) Tornabene also describes sharing and updating information such as names and addresses. (Paragraph [0007] Tornabene also describes "a group administrator" that delivers and exchanges information. (Paragraph [0008].) None of the features described in Tornabene, however, teach or suggest comparing respective first and second contact lists.

#### **identifying common and non-common contacts between the first contact list and the second contact list**

Moreover, nothing in the quoted language suggests the explicit step of identifying which contacts are common and which are non-common based on a comparison of two

different contact lists. None of the language cited in the Office Action describes this comparison. As described in the quoted language above, Tornabene invites prospective members to join a group and updates services when new members join the group. Tornabene, however, nowhere describes comparing respective contact lists. Tornabene's information "sharing" is not equivalent, nor does it suggest, the explicit step of comparing respective contact lists. Tornabene's sharing of contact information merely results in a pooling or aggregation of information. It in no way teaches or suggests determining which information is common and which is dissimilar among different members. The mere adding of new information for new members to a group does not teach or suggest explicitly identifying what information is similar to an existing set of information and what information is dissimilar.

**displaying common contacts in a first visual list and  
non-common contacts in a second visual list**

More fundamentally, Tornabene nowhere even remotely suggests the explicit step of displaying in a first visual list contacts common to two different contact lists while also displaying non-common contacts in a second visual list. As the above-quoted language reveals, Tornabene does not teach or suggest two distinct visual lists. Instead, Tornabene provides only for the "sharing" of respective lists. Nothing about this sharing, however, teaches or suggests two distinct lists. Specifically, Tornabene does not teach or suggest one visual list that lists contacts that are common to two different contact lists belonging to different chat session participants. Nor does Tornabene teach or suggest a separate, distinct list that lists each contact from the respective participants' own lists that are not common to both.

Accordingly, the combination of Gudjonsson and Tornabene fails to teach every feature recited in independent Claims 1, 23, 28, 36, and 58. Applicants respectfully

submit, therefore, that the claims, as well as each claim dependent thereon, define over the prior art.

**Claims 16 and 51**

The combination of Gudjonsson and Tornabene likewise fails to teach or suggest every feature recited in independent Claims 16 and 51. As already pointed out, it is explicitly noted in the Office Action that Gudjonsson fails to teach or suggest the steps of comparing contact lists, identifying common contacts, and presenting common and non-common contacts in two distinct lists. Tornabene also fails to teach or suggest these features, however. In particular, Tornabene fails to teach or suggest presenting similar contacts in one visual format and dissimilar contacts in a different visual format.

**presenting similar contacts in a pre-selected visual format and  
dissimilar contacts in a different visual format**

Tornabene, as the quoted language establishes, "shares" contact information and updates that information when a new member joins an established group. Tornabene, however, does not compare different contact lists to determine which list items are similar and which are dissimilar.

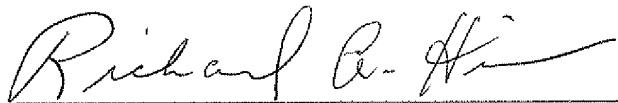
More fundamentally, Tornabene does not present similar contacts according to one visual format while presenting dissimilar contacts in a different visual format. Tornabene nowhere even suggests the presentation of information in different formats. Specifically, Tornabene does not teach or suggest presenting similar contacts drawn from different contact lists in one visual format while presenting dissimilar ones in a different and Accordingly, the combination of Gudjonsson and Tornabene fails to teach every feature recited in independent Claims 16 and 51. Applicants thus respectfully submit that the claims, as well as those dependent thereon, define over the prior art.

**CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: December 11, 2006



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